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Heiko Dassow

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EXAMINER

NGUYEN, HANH N

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/673,520	<b>Applicant(s)</b> DASSOW ET AL.	
	<b>Examiner</b> Hanh Nguyen	<b>Art Unit</b> 2668	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed on 10/3/07.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-16, 18-22 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION*****Specification***

The specification is objected to because as compared between page 10, lines 10-15 in the specification and the bottom part of figure 2, the bandwidth required for information transmission within data network 4 should be **less than** ( instead of higher than) the user information sent by the terminal. Applicant is required to make correction.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11, 13, 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 11, it appears that the specification does not describe “reducing bandwidth when transmitting data ..... over a voice connection path using a digital data network ( see specification on page 10, lines 10-15) .

In claim 13, it is not clearly addressed what is meant by “ no special functional matching of the sending and receiving terminals is required for the converting” since the specification does not describe this claim language.

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In claim 14, it is not clearly addressed what is meant by “no special adaptation of the sending and receiving terminals to transmission characteristics of the digital data network is required for the transmission of the user information”.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 11, 12, 18, 19, 20, 21, 22 are rejected under 35 USC 102(e) as being anticipated by Feder (US pat. 5,872,845).

\*In claims 11, 20, Feder discloses, in fig.1, col.4, lines 40-65; a method for reducing bandwidth ( compress fax message during transmission) when

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transmitting data (fax transmission) between a sending terminal (first fax machine 110) and a receiving terminal (second fax machine 170) over a voice connection path (phone line over PSTN) using a digital data network ( packet switched digital network 140 which may comprises Internet or private networks; col.5, lines 1-5) comprising: converting, within the digital data network, a coding of user information between a data transmission in the voice connection path and a data transmission in the digital data network (see fig.3, col.5, lines 17-25 and col.6, lines 25-40; to transmit a fax message from fax machine 110 to fax machine 170 using digital communication, interface 120 enhances its data compression by demodulating the fax at step 320, decompress at step 330, compress at step 340, and format the fax at step 350 for transmission to server 130) so as to transmit the user information via the coded voice connection path on at least one first section of the digital data network (see col.6, lines 25-30; compressed fax message transmitted between interface 120 and server 130) and transmit the user information by a method suitable for the digital data network on at least one second section of the digital data network (see col. 6, lines 40-60 and fig.4; Network 140 delivers fax packets to server 150, interface 160 which uses a data handshake protocol to establish the connection to fax machine 170).

IN claim 12, Feder discloses sending and receiving terminals use a similar modulation method for transmitting data over voice connection path ( see fig.2B, col.5, lines 55-65; interface 120 and interface 160 uses modular or 275 operating at 14.4 kbps).

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\*In claim 19, Feder discloses at least one of the sending and receiving terminals ( fax machine 110 and fax machine 170) is connected via digital link (see col.5, lines 1-3; digital telephone line such as ISDN line or T1 line) to digital data network ( digital network 140).

\*In claim 18, Feder discloses splitting user information into data packet for transmitting over the digital data network (the fax message is transmitted via digital network 140 such as Internet network, col.5, lines 1-5; therefore, the message is transmitted in packets ), a transmission rate of data packets being flexibly adapted at a network transition to a bit rate transmitted by the sending terminal (See fig.3; data transfer rate is adjusted between server 150 and interface 160).

In claim 21, Feder discloses user information conforms to features of FAX class 3 ( see col.7, lines 45-55; group 3 compressed Fax format or T.4).

\*In claim 22, Feder discloses protecting the data by cryptographic processes against at least of passive monitoring, alteration and simulation of at least one of incorrect call data and contents ( see col.3, lines 40-45; fig.3, encrypt fax message by security method well-known in the art).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

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said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15, 16 are rejected under 35 USC 103(a) as being unpatentable by Feder (US pat. 5,872,845).

In claims 15 and 16, Feder does not disclose transmitting the user information via the coded voice connection is performed automatically by a context-related call number translation during a connection setup. Fax transmission via context-related call number translation is well-known in the art. Therefore, it would have been obvious in Feder to perform context-related call number translation automatically to transmit fax via digital network.

In claim 16, as disclosed in claim 11, performing end-to-end signalling on at least one section of digital network between sending and receiving terminals are well-known in the art.

***Allowable Subject Matter***

Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In claim 17, the prior art does not disclose the sending and receiving terminals use different respective data transmission processes and further comprising temporarily storing and converting the transmitted data and signaling information so as to match the respective data transmission processes of the sending and receiving terminals such that differences in the respective data transmission processes are not perceived by the sending and receiving terminals.

### ***Response to Arguments***

Applicant's arguments with respect to claims 11-22 have been considered but claims 11-16 and 18-22 are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yamaha ( US Pat. 4,156,880).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh Nguyen whose telephone number is 571 272 3092. The examiner can normally be reached on Monday-Thursday from 8AM to 4:30PM. The examiner can also be reached on alternate .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn Feild, can be reached on 571 272 2092. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR



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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Hanh Nguyen/

Primary Examiner, Art Unit 2616